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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,140	02/16/2001	Takuji Tanimura	04791/0134	2146
44987	7590	06/24/2005	EXAMINER	
HARRITY & SNYDER, LLP 11240 WAPLES MILL ROAD SUITE 300 FAIRFAX, VA 22030			KADING, JOSHUA A	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/784,140

Applicant(s)

TANIMURA, TAKUJI

Examiner

Joshua Kading

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/01, 11/03, 7/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,570,976 B2, Asada et al. (Asada).

Regarding claims 1 and 2, Asada discloses, "a hybrid type telephony system capable of establishing a connection between conventional type telephone sets contained in an exchange unit and LAN type telephone sets contained in an IP network the system comprising:

a gateway circuit connected between the exchange unit and the IP network and performing voice data format conversion (*figure 8, element 22 acts as a gateway as described in col. 13, lines 13-16*),

a central control unit connected to the LAN of the IP network for establishing a communication path to the exchange unit via a control bus, controlling switching of IP packets of the IP network, managing IP address information of the LAN type telephone sets and the gateway circuit via the LAN, and controlling connection between the LAN type telephone sets and connection between the LAN type telephone sets and the gateway circuit (*figure 8, element 143 is a control unit that controls the switching in the unit 1C as described in col. 6, lines 15-30 and element 20 acts as control bus as indicated by bus control unit 142*),

wherein the control bus forms a communications path for enabling the central control unit to control a time-division switch for the conventional type telephone sets and an IP switch for the LAN type telephone sets (*figure 8, where bus 20 connects all components of unit 1C, including time-division switch 15, see col. 5, lines 41-45*)."

Regarding claim 21, Asada discloses, "a hybrid telephony system comprising:  
a time-division switch in which conventional type telephone sets are connected (*figure 1, element 15 is a time-division switch as described in col. 5, lines 41-45; where col. 5, lines 33-36 describe the convention telephones, i.e. the analog telephones*);

an IP switch in which LAN type telephone sets are connected (*figure 18, element 14C where the telephones T1-TM can consist of LAN type telephones as described in col. 13, lines 28-29*);

a gateway circuit which performs converting between a first voice format to connect the conventional type telephone sets and a second voice format to connect the

LAN type telephone sets (*figure 8, element 22 acts as a gateway as described in col. 13, lines 13-16*);

a LAN which connects the gateway circuit and the IP switch (*figure 8, element 21 as described in col. 13, lines 19-20*);

a control bus which connects the time-division switch, the IP switch, and the gateway circuit (*figure 8, bus 20*); and

a central control unit connected to the LAN of the IP network for establishing a communication path to the exchange unit via a control bus, controlling switching of IP packets of the IP network, managing IP address information of the LAN type telephone sets and the gateway circuit via the LAN, and controlling connection between the LAN type telephone sets and connection between the LAN type telephone sets and the gateway circuit (*figure 8, element 143 is a control unit that controls the switching in the unit 1C as described in col. 6, lines 15-30 and element 20 acts as control bus as indicated by bus control unit 142*)."

Regarding claims 16 and 19, Asada discloses, "wherein the central control unit controls establishment of connections for all calls made between any two of the LAN type telephone sets, between any two of the conventional type telephone sets, and between any one of the LAN type telephone sets and any one of the conventional type telephone sets (*figure 8, element 143 is a control unit that controls the switching in the unit 1C as described in col. 6, lines 15-30*)."

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-6, 14, 15, 17, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. in view of U.S. Patent 6,252,952 B1, Kung et al. (Kung).

Regarding claims 3 and 4, Asada lacks what Kung discloses, "the LAN type telephone sets (*figure 1, elements 22*) have IP address information of the central control unit (*col. 25, lines 58-62 where the gateway (not the residential gateway, but the gateway as described in claims 1 and 2) used in the IP network is directly connected to the control unit and the IP telephones and thus must have the IP address of the control unit so that it may send/receive data*), upon a call to one of the LAN type telephone sets from another of the LAN type telephone sets, the another of the LAN type telephone sets transmits a call requesting packet to the central control unit via the LAN according to the IP address information of the central control unit (*col. 28, lines 42-50 where the dialed digits represent a call request and as seen in lines 10-12, this is a call between two LAN type telephone sets*), inquires the central control unit about a destination IP address, and fetches the destination IP address to establish communication (*col. 26, lines 29-35 where the routing number is the destination IP address*).” It would have been obvious to one with ordinary skill in the art at the time of invention to include the

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call request and the retrieving of IP address information for the purpose of making phone connections using IP technology. The motivation for using IP technology for phone connections is to make the system more efficient through direct linking between subscribers without having to reserve a physical link (*Kung, col. 1, lines 47-50*).

Regarding claims 5 and 6, Asada lacks what Kung further discloses, "upon connection between one of the LAN type telephone sets (*figure 1, elements 22*) and one of the conventional type telephone sets, the central control unit reports the IP address of the gateway circuit to the LAN type telephone set (*col. 25, lines 58-61 where the LAN type telephone (IP telephone) must have known the gateway circuit IP address in order to access the control unit because, as seen in figure 1, the control unit is only accessible through the IP network gateway*) and the IP address of the one of the LAN type telephone sets to the gateway circuit (*col. 26, lines 41-45 whereby issuing a call proceeding message to the IP telephone, so as to establish a communication path between the conventional telephone set and the gateway circuit (where the IP telephone is accessed through the residential gateway) means the control unit was informed of the IP telephones IP address*).” It would have been obvious to one with ordinary skill in the art at the time of invention to include the IP address notification with the systems of claims 3 and 4 for the same reasons and motivation as in claims 3 and 4.

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Regarding claim 14, Asada lacks what Kung further discloses, "wherein the IP address of the central control unit is set in each of the LAN type telephone sets in advance of any call initiated by any of the LAN type telephone sets (*col. 25, lines 58-62 where it is strongly implied that each set has the central control units IP address, if this were not the case, then how would the sets place/receive calls?*)."

It would have been obvious to one of ordinary skill in the art at the time of invention to include the IP address of the central control unit in each LAN telephone set for the same reasons and motivation as in claim 3.

Regarding claims 15 and 18, Kung lacks what Asada further discloses, "the time-division switch provided in the exchange unit for providing time-division data transfer among the conventional type telephone sets (*figure 8, element 15*), wherein the central control unit controls the time-division switch by way of the control bus, to allow data to be sent to the one of the conventional type telephone sets via the gateway unit and the time-division switch along the communication path established between the one of the conventional type telephone sets and the gateway circuit (*figure 8, elements 15 and 143*)."

It would have been obvious to one of ordinary skill in the art at the time of invention to include the time-division provided in the exchange and the central control unit controlling the LAN telephone sets and conventional telephone sets for the same reasons and motivation as in claims 5 and 6.



Regarding claims 17 and 20, Asada lacks what Kung discloses, "a maintenance and management terminal that is communicatively connected to the central control unit via the control bus (*figure 2, element 216*), wherein the maintenance and management terminal is configured to perform maintenance and management for the hybrid telephony system, so that the central control unit can set control data and monitor control (*col. 8, lines 15-21*).” It would have been obvious to one of ordinary skill in the art at the time of invention to include the maintenance and management terminal configured to perform the corresponding functions for the controlling the overall function of components of the network (*Kung, col. 8, lines 15-21*). The motivation for having a controlling unit is simply so the device can operate within the network so as to provide the additional functionality of IP based telephone calls (*Kung, col. 1, lines 47-50*).

6. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. in view of U.S. Patent 6,754,224 B1, Murphy.

Regarding claims 7 and 8, Asada lacks what Murphy further discloses, "the central control unit assigns a single extension representation telephone number for the plurality of conventional type telephone sets and the plurality of LAN type telephone sets as a single group and, upon a call from one of the conventional telephone sets or the LAN type telephone sets using the extension representation telephone number, performs a call-incoming processing to all the telephone sets in the group (*col. 7, lines 1-18 where there can be an incoming multicast call, thus implying a single extension/number used to address the multicast group, directed to the conventional sets*

*and the LAN sets).*" It would have been obvious to one with ordinary skill in the art at the time of invention to include the prefix dialing for the purpose of alerting all users belonging to a particular group. The motivation for this is that only one number has to be dialed for all the users instead of each user's distinct number, thus saving time.

7. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asada et al. and Kung et al. as applied to claims 3-6 above, and further in view of Murphy.

Regarding claim 9-12, Asada and Kung lack what Murphy further discloses, "the central control unit assigns a single extension representation telephone number for the plurality of conventional type telephone sets and the plurality of LAN type telephone sets as a single group and, upon a call from one of the conventional telephone sets or the LAN type telephone sets using the extension representation telephone number, performs a call-incoming processing to all the telephone sets in the group (*col. 7, lines 1-18 where there can be an incoming multicast call, thus implying a single extension/number used to address the multicast group, directed to the conventional sets and the LAN sets).*" It would have been obvious to one with ordinary skill in the art at the time of invention to include the prefix dialing for the purpose of alerting all users belonging to a particular group. The motivation for this is that only one number has to be dialed for all the users instead of each user's distinct number, thus saving time.

### ***Response to Arguments***

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8. Applicant's arguments, see REMARKS, page 13, second full paragraph, filed 6 June 2005, with respect to the rejections of all claims have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

### ***Conclusion***

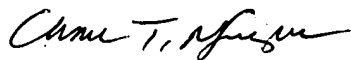
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Joshua Kading  
Examiner  
Art Unit 2661

June 16, 2005

  
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